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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

FRISBY, KESHA

ART UNIT PAPER NUMBER

3715

DATE MAILED: 09/25/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/647,334

Applicant(s)

TAMURA ET AL.

Examiner

Kesha Frisby

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 August 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 8/26/2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 8/26/2003.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Priority

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-4, 7 & 8 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. For claims 1, 3 & 4, in order for a method to be statutory it must have a practical application of another wise abstract. A practical application may be achieved through either: a) a physical transformation or b) an otherwise useful, concrete and tangible result. To show a physical transformation, the method must physically transform an article or physical object to a different state or thing. This is not achieved in this method because this method in the end only transmits information. Further, the method fails to show a tangible result. In order for a method to be tangible it must show a real-world or perceivable result. In the instant case, the method results in only transmitting information, which is not, a real-world result because nothing is stated as to what happens after the information is transmitted. For instance, is the information displayed after the information is transmitted? Dependent claim 2 does not correct this problem therefore this claim is also rejected.

In claim 7, the non-statutory matter is the "computer program". This manipulates an Abstract Idea (computer program) without producing a "useful, concrete and tangible

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result.” Claim 7 is nothing more than units being used to run the program. In addition, claim 7, is directed to software lacking storage on a medium, which enables any underlying functionality to occur. As such, the claimed invention does not process a “real world” value but rather represents nothing more than an idea or what is needed to make the program work. See MPEP 2106 for guidance. Dependent claim 8 does not cure the deficiency therefore claim 8 is also rejected.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 3 & 4 are rejected under 35 U.S.C. 102(b) as being anticipated by Toshiya (English Machine Translation of JP 2001-273375 A).

Referring to claim 3, Toshiya discloses receiving a transmission request for transmitting said pass/fail information transmitted from said examinee terminal (paragraphs 0007 & 0008: inquiry from the user), said transmission request based on a pass/fail information address in said network which said pass/fail information is located (paragraph 0017: A means to use a website ... the user information input means 1); and transmitting, in response to reception of said transmission request, a plurality of examinee ID numbers around an examinee ID number of said examinee (paragraph 0023: successful candidate files).

Referring to claim 4, Toshiya discloses transmitting to said examinee terminal an enquiry to said examinee asking whether said examinee wishes to disclose said pass/fail information other examinees (paragraph 0003: the examiner view this limitation as the use of electronic mail/e-mail as a form of communication); receiving a response by said examinee terminal to said transmitted enquiry (paragraphs 0007 & 0008: inquiry from the user of Toshiya); grouping, based on profile information of the plurality of examinees, examinees whose responses indicate a wish to disclose said pass/fail information to other examinees (paragraph 0016: successful candidate table & paragraph 0023: successful candidates); and transmitting pass/fail information of the grouped examinees to said examinee terminals of the grouped examinees (paragraph 0023).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1, 2 & 5-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Toshiya (English Machine Translation of JP 2001-273375 A) in view of Fujimoto et al. (U.S. Patent Number 7,013,429).

Referring to claim 1, Toshiya discloses transmitting a confirmation mail to said examinee terminal asking whether to require said pass/fail information (paragraph 003: the examiner view this limitation as the use of electronic mail/e-mail as a form of

communication); receiving a response mail returned by said examinee terminal in response said confirmation mail (paragraphs 0001, 0007 & 0008: the examiner views this limitation as the user making an inquiry to receive the result of the passing status via electronic mail/e-mail). *Toshiya does not disclose recording reception time at which said server receives said response mail; determining, based on said reception time, a transmission order by which transmit said examinee terminal a pass/fail information address in said network at which said pass/fail information is located; and transmitting said pass/fail information address to a predetermined number of said examinee terminals depending on said transmission order and server load value indicating load on said server and/or said network.* However, Fujimoto et al. teaches recording reception time at which said server receives said response mail (this is an inherent feature in electronic mail transmission/reception systems); determining, based on said reception time, a transmission order by which transmit said examinee terminal a pass/fail information address in said network at which said pass/fail information is located (mail server 201); and transmitting said pass/fail information address to a predetermined number of said examinee terminals depending on said transmission order and server load value indicating load on said server and/or said network (the examiner views this limitation as through the use of the mail server 201 the website for obtaining the pass/fail information will be transmitted via the use of electronic mail). It would have been obvious to one of ordinary skill in the art at the time the invention was made to include recording, determining and transmitting, as disclosed by Fujimoto et al., incorporated into Toshiya in order to be able to manage the electronic mail system.

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Referring to claim 2, Toshiya, as modified by Fujimoto et al., discloses further comprising the steps of: receiving transmission request for transmitting said pass/fail information transmitted from said examinee terminal (paragraphs 0007 & 0008: inquiry from the user of Toshiya), said transmission request based on said pass/fail information address (paragraph 0017: A means to use a website ... the user information input means 1) and transmitting said pass/fail information in response to said transmission request (paragraph 0005: notify the result of the passing status of Toshiya).

Referring to claim 5, Toshiya discloses a transmitting unit that transmits a confirmation mail to said examinee terminal asking whether to require said pass/fail information (paragraph 003: the examiner view this limitation as the use of electronic mail/e-mail as a form of communication); a receiving unit that receives a response mail returned by said examinee terminal in response to said confirmation mail (paragraphs 0001, 0007 & 0008: the examiner views this limitation as the user making an inquiry to receive the result of the passing status via electronic mail/e-mail). *Toshiya does not disclose a determining unit that records reception time at which said response mail is received and determine, based on said reception time, a transmission order by which to transmit to said examinee terminal a pass/fail information address at which said pass/fail information is located; and a transmitting unit that transmits said pass/fail information address to a predetermined number of said examinee terminals depending on said transmission order and a load value indicating a load on said transmitting apparatus.* However, Fujimoto et al. teaches determining unit that records reception time at which said response mail is received and determine (this is an inherent feature in electronic

mail transmission/reception systems), based on said reception time, a transmission order by which to transmit to said examinee terminal a pass/fail information address at which said pass/fail information is located (mail server 201); and a transmitting unit that transmits said pass/fail information address to a predetermined number of said examinee terminals depending on said transmission order and a load value indicating a load on said transmitting apparatus (the examiner views this limitation as through the use of the mail server 201 the website for obtaining the pass/fail information will be transmitted via the use of electronic mail). It would have been obvious to one of ordinary skill in the art at the time the invention was made to include a determining and transmitting unit, as disclosed by Fujimoto et al., incorporated into Toshiya in order to be able to manage the electronic mail system.

Referring to claim 6, Toshiya, as modified by Fujimoto et al., teaches wherein the transmitting unit transmits said pass/fail information address to the predetermined number of examinee terminals when the load value indicating the load on said transmitting apparatus is less than a predetermined value (the capabilities of mail server 201 of Fujimoto et al.).

Referring to claims 7 & 9, Toshiya discloses a transmitting unit that transmits a confirmation mail to an examinee terminal used by an examinee asking whether said examinee requires pass/fail information indicating whether said examinee has passed or failed an exam (paragraph 003: the examiner view this limitation as the use of electronic mail/e-mail as a form of communication); a receiving unit that receives a response mail returned in response to said confirmation mail from said examinee

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terminal (paragraphs 0001, 0007 & 0008: the examiner views this limitation as the user making an inquiry to receive the result of the passing status via electronic mail/e-mail).

Toshiya does not disclose a determining that records reception time at which said response mail is received and determines, based on said reception time, transmission order by which to transmit to said examinee terminal a pass/fail information address at which said pass/fail information is located; and a transmitting unit that transmits said pass/fail information address to predetermined number of said examinee terminals depending on said transmission order and a load value indicating load or said computer.

However, Fujimoto et al. teaches a determining that records reception time at which said response mail is received and determines (this is an inherent feature in electronic mail transmission/reception systems), based on said reception time, transmission order by which to transmit to said examinee terminal a pass/fail information address at which said pass/fail information is located (mail server 201); and a transmitting unit that transmits said pass/fail information address to predetermined number of said examinee terminals depending on said transmission order and a load value indicating load or said computer (the examiner views this limitation as through the use of the mail server 201 the website for obtaining the pass/fail information will be transmitted via the use of electronic mail). It would have been obvious to one of ordinary skill in the art at the time the invention was made to include a determining and transmitting unit, as disclosed by Fujimoto et al., incorporated into Toshiya in order to be able to manage the electronic mail system.

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Referring to claims 8 & 10, Toshiya, as modified by Fujimoto et al., teaches wherein the transmitting unit transmits said pass/fail information address to the predetermined number of examinee terminals when the load value indicating the load on said transmitting apparatus is less than a predetermined value (the capabilities of mail server 201 of Fujimoto et al.).

Citation of Pertinent Prior Art

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Christenson et al. (U.S. Publication Number 2002/01120008) teaches an electronic mail system with methodology providing distributed message storage and processing.

Colby (U.S. Patent Number 2003/0077560) teaches a medical education system.

Ho et al. (U.S. Patent Number 5,727,951) teaches a relationship-based computer-aided-educational system.

Martinez et al. (U.S. Patent Number 5,211,564) teaches a computerized figural response testing system and method.

Conclusion


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kesha Frisby whose telephone number is 571-272-8774. The examiner can normally be reached on Mon. - Wed. 7-3pm, Thu. 6:30-4pm & Fri. 7-4pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Olszewski can be reached on 571-272-6678. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Kyf
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